

### **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 19 is requested to be cancelled without prejudice or disclaimer.

Claims 1, 16, 17, and 23-26 are currently being amended.

New claims 28-33 are being added.

This amendment changes, deletes and adds claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-18 and 20-33 are now pending in this application.

#### **Examiner interview**

Applicants appreciate the personal interview of January 7, 2004 with Examiner Chase. Applicant's representative and Examiner Chase discussed the scope of the phrase "information about the usage of the memory card" in the claims. The Shimizu reference was also discussed. Applicant's representative explained that the Shimizu did not disclose storing information about the usage of the memory card on the memory card. Examiner Chase was of the opinion that this feature was disclosed in Shimizu.

#### **Rejections under 35 U.S.C. § 112, first paragraph and second paragraph**

Claim 19 stands rejected under 35 U.S.C. 112, first paragraph and under 35 U.S.C. 112, second paragraph. These rejections are moot in light of the cancellation of claim 19.

#### **Rejections under 35 U.S.C. §§ 102 and 103**

Claims 1-17 and 19-22 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication #2002/0107832 A1 to Shimizu et al. (hereafter "Shimizu"). Claims 23-26 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,478,679 to Himoto et al. (hereafter "Himoto"). Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu and U.S. Patent No. 5,532,689 to

Bueno (hereafter “Bueno”). Claim 27 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu and U.S. Patent No. 6,587,140 to No (hereafter “No”). Claim 19 has been cancelled. With respect to the remaining claims, applicants traverse these rejections for at least the following reasons.

#### **Claims 1-22**

Independent claim 1 recites collecting information about usage of a memory card, and recording the information about usage of the memory card in an area of the memory card. Neither Shimizu, nor the remaining references cited in the rejection, suggest collecting information about usage of a memory card, and recording the information about usage in an area of the memory card.

Shimizu fails to disclose collecting information about usage of a memory card, and recording that information in an area of the memory card. The Office Action cites to paragraphs 15 and 61 of Shimizu as disclosing this feature. Shimizu discloses in paragraph 15, updating advertisement usage information, which may include a record of the number of times a user has used a website, everytime a user accesses the website or purchases on the website. In paragraph 61, Shimizu discloses recording generated use condition information and billing information in a control information storage unit 726, where the use condition information includes period of rent, number of times reproduction is possible, and whether or not copying is allowed.

Shimizu, however, fails to disclose recording information on the usage of a memory card in either paragraphs 15 or 61 (cited in the Office Action), or anywhere else in Shimizu. Applicants submit that the number of times a website has been accessed cannot reasonably be interpreted as the usage of a memory card, whether or not the number of times is stored on the memory card. Moreover, the generated use condition information and billing information disclosed in paragraph 61 is directed to rental of a DVD (see Shimizu, paragraph 61), and also cannot be reasonably interpreted as usage of a memory card. For example, the number of times the reproduction is possible concerns reproduction of a DVD, not the usage of a memory card.

With regards to the detail of the disclosure of the prior art, the invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*,

868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Shimizu at best discloses storing a record of information concerning the use of rented DVDs, or the number of times a website has been accessed. This information is simply not the usage of a memory card.

Bueno fails to cure the deficiencies of Shimizu. Bueno was cited for allegedly disclosing counting the number of times a memory card is inserted into an electronic device. Bueno, however, also fails to disclose or suggest collecting information about usage of a memory card, and recording the information about usage in an area of the memory card.

Independent claim 14 is directed to a data structure in a memory card. The data structure comprises computer readable storage containing at least one event descriptor about the usage of the memory card, and for each event descriptor a count representing the number of occurrences of that event. Shimizu and Bueno both fail to disclose a computer readable storage containing at least one event descriptor about the usage of the memory card. Thus, claim 14 is likewise patentable over Shimizu and Bueno.

Independent claim 16 is directed to a system for storing memory card usage information on a memory card, comprising a component for collecting information about usage of the memory card, and component for recording the information about usage of the memory card in an area of the memory card. As discussed above with respect to claim 1, Shimizu and Bueno fail to disclose or suggest collecting information about the usage of a memory card, and storing that information in an area of the memory card. Thus, claim 16 is patentable over Shimizu and Bueno for at least the same reasons as claim 1.

Independent claim 17 is directed to a method. The method comprises collecting information about usage of a portable memory card in an electronic device, and recording the information about usage of the memory card on the memory card itself. Shimizu and Bueno fail to disclose collecting information about usage of a portable memory card in an electronic device, and recording the information about the usage on the memory card itself. Thus, claim 17 is likewise patentable over Shimizu and Bueno.

Dependent claims 2-13, 15, and 18 and 20-22 depend from one of independent claims 1, 14 and 17, and are allowable for at least the same reasons, as well as for patentable features recited therein.

#### **Claims 23-27**

Claim 23 requires monitoring usage of the memory card, and storing the usage of the memory card on the memory card. Himoto fails to disclose this feature of claim 23. Himoto discloses a memory card 10 with an LCD 14 that displays information such as game number and game scores (see Figures 7-8B). Himoto, however, does not disclose monitoring usage of the memory card, and storing the usage of the memory card on the memory card. The information displayed on the LCD 14 of Himoto, whether stored in the memory card 10 or not, cannot reasonable be interpreted as usage of the memory card. Thus, Himoto fails to disclose or suggest features recited in claim 23, and claim 23 is patentable thereover for at least this reason.

No fails to cure the deficiencies of Himoto. No was cited for allegedly disclosing a memory card for use in a digital camera. No, however, also fails to disclose or suggest monitoring usage of the memory card, and storing the usage of the memory card on the memory card.

Dependent claims 24-27 depend from claim 23, and are allowable for at least the same reasons, as well as for patentable features recited therein

For at least the above reasons applicants respectfully request that the rejections under 35 U.S.C. 102(e) and 103(a) be withdrawn.

### **Double Patenting**

Claims 17 and 23 stand as provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 17 and 21 of copending Application No. 10/052,098 (the “’098 application”). Applicant respectfully traverses this rejection. Presently pending claims 17 and 21, along with independent claim 13 from which claim 17 depends, of the ‘098 application are reproduced below.

13. A removable, nonvolatile memory card, comprising:

at least one memory module;

a card controller; and

a nonvolatile storage space display provided on the exterior of the memory card that indicates the amount of storage space that is available.

17. The memory card of claim 13, wherein the display is a cholesteric liquid crystal display.

21. A method for indicating the amount of storage space available from a storage device, comprising the steps of:

determining the amount of storage space that is available in at least one memory module;

updating a nonvolatile display of the storage device so that it conveys the amount of available space.

As is clear from a comparison, claim 17 of the present application and claim 17 of the '098 application have a clearly different scope. Likewise, the scope of claim 23 of the present application and claim 21 of the '098 application is clearly different. A statutory double patenting rejection is only proper when the claims of an application are identical in scope with the claims of a patent, or patent application. Thus, applicant submits that the rejection of claims 17 and 23 of the present application under 35 U.S.C. 101 as claiming the same invention as that of claims 17 and 21 of the '098 application is improper and should be withdrawn.

#### **New claims 28-33**

New claims 28-33 have been added reciting further patentable features not disclose or suggested in the references discussed above.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to

Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date January 12, 2004

FOLEY & LARDNER  
Washington Harbour  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007-5143  
Telephone: (202) 672-5485  
Facsimile: (202) 672-5399

By Thomas G. Bilodeau

William T. Ellis  
Attorney for Applicant  
Registration No. 26,874

Thomas G. Bilodeau  
Attorney for Applicant  
Registration No. 43,438